REMARKS

Claims 1, 3-5, and 7-20 were pending in the present application. Claims 1, 3-5, and 7-20 have been canceled herein without prejudice to their presentation in another application. New claims 21-24 have been added herein support for which can be found throughout the specification and original claims, and also in Example 1 of the specification. No new matter has been added. Applicants reserve the right to prosecute the cancelled claims in the present application or any continuation application that may be filed. Upon entry of the present amendment, claims 21-24 will be pending.

I. The Claimed Invention Is Novel

Claims 1, 3-5, 7-12, 16, 17, and 19 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by International Application Publication WO 01/92263 (hereinafter, the "Larsson reference"). Applicants traverse the rejection and respectfully request reconsideration because the Larsson reference does not teach every feature recited in new claims 21-24. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

II. The Claimed Invention Is Not Obvious

A. The Combination of Larsson and Krauter References

Claims 1, 3-5, and 7-20 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Larsson reference in view of U.S. Patent No. 6,818,720 (hereinafter, the "Krauter reference"). Applicants traverse the rejection and respectfully request reconsideration because the Larsson reference does not teach every feature recited in new claims 21-24 and the Krauter reference does not cure the deficiencies of the Larsson reference. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

B. The Combination of Fisons and Guile References

Claims 1, 3-5, and 7-20 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the EP 0508687 (hereinafter, the "Fisons reference") in view of PCT Publication WO 99/05143 (hereinafter, the "Guile reference"). Applicants traverse the rejection

and respectfully request reconsideration because the combination of the Fisons and Guile references does not teach every feature recited in new claims 21-24. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

III. Obviousness-type Double-Patenting

Claims 1, 3-5, and 7-20 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 2 and 3 of U.S. Patent No. 7,067,663 (hereinafter, the "Larsson Patent"). Applicants traverse the rejection and respectfully request reconsideration.

An obviousness-type double patenting rejection is analogous to a failure to meet the nonobviousness requirement of 35 U.S.C. §103. *In re Braithwaite*, 154 U.S.P.Q. 29, 34 (C.C.P.A. 1967) and *In re Longi*, 225 U.S.P.Q. 645, 648 n.4 (Fed. Cir. 1985). Thus, under the law, the pivotal question in an obviousness-type double patenting analysis is: Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent? *In re Vogel*, 164 U.S.P.Q. 619 (C.C.P.A. 1970). If the answer to this question is no, there can be no double patenting. In making this analysis, then, the proper inquiry is as taught in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). See, M.P.E.P. §804. No such analysis has been performed by the Office.

Claim 2 of the Larsson Patent recites a "process for preparing a compound of formula (I) as claimed in claim **1**…". The compound of formula (I) in the Larsson Patent is a different compound and not even within the scope of the claims of the present application. Claim 2 of the Larsson Patent also recites "hydrogenating a compound of formula (IV)". In contrast, Applicants new claims recite a process whereby a compound which does not comprise formula (IV) of the Larsson Patent is hydrogenated. Moreover, claim 2 of the Larsson Patent requires another step, i.e., reacting the compound of formula (II) with a salt of a compound of formula (III), neither of which are within the scope of Applicants' new claims. Further, claim 3 of the Larsson Patent recites intermediates that are not within the scope of the new claims of the present application. Applicants fail to understand how claims 2 and 3 of the Larsson Patent which start with different compounds, employ different steps, and end up with different end compounds could possibly render the new claims of the present application obvious.

IV. Conclusion

Applicants respectfully submit that the claims are in condition for allowance. An early notice of the same is earnestly solicited. The Examiner is invited to contact Applicants' undersigned representative at 610.640.7859 to resolve any remaining issues.

The Commissioner is hereby authorized to debit any underpayment of fee due or credit any overpayment to Deposit Account No. 50-0436.

Respectfully submitted,

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